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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,554	11/28/2001	Huub Van Aert	27500-13	2836

7590

06/09/2003

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EXAMINER

FUNK, STEPHEN R

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 06/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/996,554

Applicant(s)  
Van Aert et al.

Examiner  
Stephen Funk

Art Unit  
2854



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 31, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above, claim(s) 9-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3 6) ☐ Other:

Claims 9 - 11 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 5.

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file. However, it is noted that priority document EP 00000003.4 filed on 12/20/2000 does not provide support for the claimed invention, in particular, the limitation in claim 1 of increasing the run length by a factor of 5 when reducing the particle size of the polymer particles. Compare the last several pages of the instant specification with the last several pages of the priority document.

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The filing date January 26, 2000 of the provisional application Serial No. 60/264,480 is incorrect. It should be January 26, 2001.

The abstract of the disclosure is objected to because it contains the legal phraseology "said". Correction is required. See MPEP § 608.01(b).

The disclosure is objected to because of the following informalities: On page 2 line 4 "composition" is misspelled; on page 2 line 9 and pages 37+ the underlining is improper as such is reserved for reissue applications and amendments; on page 4 last line "are containing" should be corrected; and on page 30 lines 1 - 2 "is thus provide" should be corrected. Applicant should

carefully review the specification for any additional errors. Although not improper per se, it is noted that Table 5 shows an increase of the run length by a factor of 50, not 5 as discussed in the following paragraph. Appropriate correction is required.

Claims 2 and 6 are objected to because of the following informalities:

In claim 2 line 2 "are containing" should be corrected.

In claim 6 line 1 "a hydrophilic polymer binder" is a double recitation of the same in claim 1 line 8 as it is already positively recited that the hydrophilic polymer binder is in the image forming layer. If applicant intends to claim that an adjacent layer may also have a hydrophilic polymer binder then the claim should be amended to accurately reflect this intention.

Claims 1 - 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 last paragraph it is not clear how the recitation of providing an increased run length "when" the particle size is reduced affects the scope of the claim. First, it is not clear if the claim positively requires a second or additional printing run with a reduced particle size compared to a first printing run. If the second run is optional, then this limitation has no bearing on the scope of the claim. Second, if a second run is positively recited then the claim must specifically recite two different print runs. Otherwise, it could not be determined if there ever was a first print run. In other words, it would appear to be impossible to increase the run length by a factor of 5 if there is no basis of comparison, i.e. compared to the first print run. Third, reducing the average particle size in an amount of more than 25% for the average particle size in

the range of 0.015 to 0.019 microns would take the average particle size out of the overall recited range. Furthermore, in lines 1 - 2 the preamble sets forth a printing system but the body of the claim recites method steps of using the system. This would appear to claim two different statutory classes of invention in the same claim.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1 - 8 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 1 appears to recite both an apparatus and method of using in the same claim.

Due to the indefiniteness of claim 1 the prior art of record cannot be applied at this time.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note paragraph [0121] of Ide et al. (EP 1,172,229) which discloses that reduced particle size only increases resolution; column 6 lines 11 - 15 of Vermeersch et al. (US 5,948,591); column 5 lines 51 - 64 of Kanda et al. (US 5,837,421); page 3 lines 35 - 43 of Van Damme et al. (EP 849,091); and Examples 1, 5, and 6 of Gardner et al. (EP 599,510).

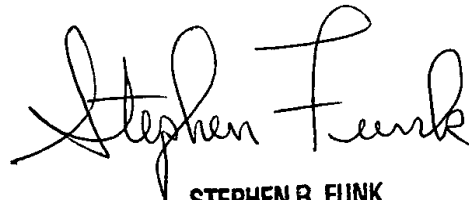
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Monday - Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Stephen Funk  
June 3, 2003



STEPHEN R. FUNK  
PRIMARY EXAMINER